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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,095	06/25/2003	Matthias Krull	2000DE441/D	4206
25255	7590	11/14/2006		
CLARIANT CORPORATION INTELLECTUAL PROPERTY DEPARTMENT 4000 MONROE ROAD CHARLOTTE, NC 28205			EXAMINER TOOMER, CEPHIA D	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,095

Applicant(s)

KRULL ET AL.

Examiner

Cephia D. Toomer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on August 24, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7 and 11-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 24, 2006 has been entered.
2. The 103 rejection over WO015739 in view of Krull and Weer is withdrawn in view of Applicant filing a certified translation of the priority document.

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 7 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending

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Application No. 10/938,495. Although the conflicting claims are not identical, they are not patentably distinct from each other because the additive claim of the present invention recites a solvent. However, the claims of the copending application are open to the inclusion of a solvent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not support the language "at room temperature".

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7 and 11-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 11001692 in view of Krull (US 5,391,632).

JP teaches a low sulfur middle distillate fuel oil comprising less than 0.2 wt % sulfur. The fuel oil contains from 0.001-0.5 wt % of a C<sub>8</sub>-C<sub>30</sub> fatty acid mixture which contains unsaturated fatty acids having a single double bond and a fatty acid containing two double bonds and other additives such as flow improvers. The acids are used in a ratio of 1:3 to 15:1 (see claim 1). At paragraphs 16 and 17, JP teaches adding saturated fatty acids and resin acids to the mixture. JP teaches the use of nitrogen-containing compounds (amides/salts) that function as cold temperature fluidity improvers (paraffin dispersants) at a ratio of 1:10-5:1 (see paragraphs 0019-0020). The fluidity improvers also include copolymers such as ethylene vinyl esters. JP also teaches that the fuel additive may be prepared as a concentrate containing 20 to 80% by weight solvent (see paragraph 24). JP teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, JP differs from the claims in that it does not specifically teach the claimed polar nitrogen-containing compound. However, Krull teaches this difference.

Krull teaches terpolymers based on unsaturated dicarboxylic anhydrides, bivalent compounds and polyoxyalkylene ethers. These terpolymers are the same as those of the instant claims (see col. 2, lines 34-68; col. 3, lines 1-68; col. 4, lines 1-35). Krull teaches that the terpolymers are used as paraffin inhibitors in crude oils and petroleum

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products such as middle distillates (see col. 9, lines 19-26). The terpolymers are used in an amount from 10-10,000 ppm (see col. 9, lines 32-35).

It would have been obvious to one of ordinary skill in the art to add the paraffin dispersant of Krull with those of JP because Krull teaches that combining the nitrogen-containing compounds of his invention with other cold temperature fluidity improvers, such as those set forth in JP result in paraffin crystals that precipitate on cooling and remaining dispersed (see col. 2, lines 21-32; col. 9, lines 44-65).

In the second aspect, JP differs from the claims in that it does not specifically teach the iodine number of the fatty acid mixture. However, since the fuel additive of JP comprises a major amount of unsaturated acids it would be reasonable to expect that the iodine number of the fatty acid mixture would be at least 40 g of I/100g, absent evidence to the contrary.

### ***Response to Arguments***

7. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that JP fails to teach the additive containing a mixture of fatty acids and the terpolymer polar nitrogen-containing compound.

JP teaches a mixture of fatty acids and terpolymers and Krull teaches that the terpolymers and copolymers of JP may be combined with terpolymers as set forth in the present invention and possess excellent action as paraffin dispersants in middle distillates (col. 10, lines 26-30).

Applicant argues that there is no motivation to combine JP and Krull to arrive at a storage stable composition.

JP recognizes that at low temperature the stability of the composition becomes an issue. Hence, it teaches the addition of low-temperature flow improving agents.

Applicant argues that JP fails to teach the claimed iodine number of the mixture of fatty acids or the proportions of the nitrogen-containing amides and salts.

The Iodine number is a measure of unsaturation. Since the fatty acid mixture taught by JP comprises at least 75% unsaturated fatty acids, it would be reasonable to expect that the Iodine Number of the fatty acid mixture would be at least 40 g/100 ml I.

Applicant argues that JP does not teach or suggest that the fatty acid mixture is a paraffin inhibitor.

Applicant has not shown that the fatty acid of the present invention functions as a paraffin inhibitor because the showings are not commensurate in scope in the claims. The showings are limited to specific fatty acids and proportions, as well as specific terpolymers and proportions. The claims as drafted are open to any fatty acid having 6 to 50 carbon atoms and at any proportion from 99.99% to 10% by weight. The examiner cannot ascertain if the fatty acid functions as a paraffin inhibitor nor if unexpected results are obtained. Furthermore, Applicant states that the fatty acid mixture functions as a lubricity additive and not as a paraffin inhibitor (see instant specification, paragraph 11).


Applicant argues that claim 11 is allowable because the blending takes place at or below room temperature.

There is nothing in JP or Krull that suggests that the blending occurs at any temperature other than room temperature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 571-272-1126. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Cephia D. Toomer  
Primary Examiner  
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